



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,263	07/15/1999	DAVID W. DEATON	026656.0283	4903

7590 12/19/2001
BAKER & BOTTS LLP
2001 ROSS AVENUE
DALLAS, TX 752012980

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
----------	--------------

2164

DATE MAILED: 12/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

H-G

Office Action Summary

Application No.

09/354,263

Applicant(s)

DEATON ET AL.

Examiner

JAGDISH N PATEL

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 July 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-95 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-48 and 71-79 are drawn to a method and system for communicating product purchase data associated with product purchased by a customer, and incentive data between a point-of-sale and one or more remote computers on a substantially real-time basis.

II. Claims 49-58 are, drawn to detecting, compiling and communicating incentives to a plurality of customers.

III. Claims 59-70 are drawn to a method of marketing based on product sales from a retail store wherein product prices are adjusted based on product purchase information.

IV. Claims 80-84 and 92-95 are directed to a method of coupon redemption based on the coupon data and product purchase data.

V. Claims 85-91 are directed to a method of marketing with electronic shelf tag for price of an item communicated via a communication link.

VI. CLAIMS 96-97 are directed to a method of marketing wherein product price information is communicated of to a customer based upon a shopping list received from the customer.

2. Inventions I-VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

3. In the instant case, Group I has separate utility over Groups II-VI such as communicating point-of-sale data to a remote computer and receiving data indicative of the prices and purchase incentives or advertisements for receipt by a customer on a real-time basis at the point-of-sale. This subcombination is distinct from Group II-VI subcombinations as explained below:

- a. Group I invention lacks group II's feature of detecting at a computer a plurality of incentives to be communicated to a plurality of customers and compiling all incentives associated with respective customers into a single document.
- b. Group I invention lacks group III's feature of communicating a price variation for a product in response to determination that a desired product purchase criteria is achieved.
- c. Group I invention lacks Group IV's feature of automatically communicating credit to the retail store for redemption of coupons presented by a customer.
- d. Group I invention lacks Group V's feature of communicating the price of an item to be displayed to an electronic shelf tag from a computer connected to the Internet.
- e. Group I invention lacks Group VI's feature of receiving shopping list of a customer and in response communicating to the customer price information from a plurality of retail stores.

4. Group II has separate utility over groups I and III-VI such as detecting product purchase information from a plurality of customers at a remote computer, detecting a plurality of incentives and compiling all incentives into a single document. This subcombination is distinct from Group I and III-VI subcombinations as explained below:

- a. Group II invention lacks group I's feature of communicating product purchase data associated with product purchase by a customer and incentive data between point-of-sale and one or more remote computers on a substantially real-time basis.

- b. Group II invention lacks group III's feature of communicating a price variation for a product in response to determination that a desired product purchase criteria is achieved.
- c. Group II invention lacks Group IV's feature of automatically communicating credit to the retail store for redemption of coupons presented by a customer.
- d. Group II invention lacks Group V's feature of communicating the price of an item to be displayed to an electronic shelf tag from a computer connected to the Internet.
- e. Group II invention lacks Group VI's feature of receiving shopping list of a customer and in response communicating to the customer price information from a plurality of retail stores.

5. Group III has separate utility over Groups I, II and IV-VI such as adjusting product prices based on the product purchase information. Group III subcombination is distinct from Group I, II and IV-VI subcombinations as explained below:

- a. Group III invention lacks group I's feature of communicating product purchase data associated with product purchase by a customer and incentive data between point-of-sale and one or more remote computers on a substantially real-time basis.
- b. Group III invention lacks group II's feature of detecting at a computer a plurality of incentives to be communicated to a plurality of customers and compiling all incentives associated with respective customers into a single document.
- c. Group III invention lacks Group IV's feature of automatically communicating credit to the retail store for redemption of coupons presented by a customer.
- d. Group III invention lacks Group V's feature of communicating the price of an item to be displayed to an electronic shelf tag from a computer connected to the Internet.

- e. Group III invention lacks Group VI's feature of receiving shopping list of a customer and in response communicating to the customer price information from a plurality of retail stores.
6. Group IV has separate utility over Groups I-III and V-VI such as coupon redemption based on coupon data. This subcombination is distinct from Group I-III and and V-VI subcombinations as explained below:
- a. Group IV invention lacks group I's feature of communicating product purchase data associated with product purchase by a customer and incentive data between point-of-sale and one or more remote computers on a substantially real-time basis.
 - b. Group IV invention lacks group II's feature of detecting at a computer a plurality of incentives to be communicated to a plurality of customers and compiling all incentives associated with respective customers into a single document.
 - c. Group IV invention lacks Group III's feature of communicating a price variation for a product in response to determination that a desired product purchase criteria is achieved.
 - d. Group IV invention lacks Group V's feature of communicating the price of an item to be displayed to an electronic shelf tag from a computer connected to the Internet.
 - e. Group IV invention lacks Group VI's feature of receiving shopping list of a customer and in response communicating to the customer price information from a plurality of retail stores.
7. Group V has separate utility over Groups I-IV and VI such as generating and displaying the price of an item by an electronic shelf at a location proximate to the item. This subcombination is distinct from Group I-IV and and VI subcombinations as explained below:

Art Unit: 2164

- a. Group V invention lacks group I's feature of communicating product purchase data associated with product purchase by a customer and incentive data between point-of-sale and one or more remote computers on a substantially real-time basis.
- b. Group V invention lacks group II's feature of detecting at a computer a plurality of incentives to be communicated to a plurality of customers and compiling all incentives associated with respective customers into a single document.
- c. Group V invention lacks Group III's feature of communicating a price variation for a product in response to determination that a desired product purchase criteria is achieved.
- d. Group V invention lacks Group IV's feature of automatically communicating credit to the retail store for redemption of coupons presented by a customer.
- e. Group V invention lacks Group VI's feature of receiving shopping list of a customer and in response communicating to the customer price information from a plurality of retail stores.

8. Group VI has a separate utility over groups I-V such as providing price information from a plurality of retail stores to a customer based on a shopping list received from the customer. This subcombination is distinct from Group I-V subcombinations as explained below:

- a. Group VI invention lacks group I's feature of communicating product purchase data associated with product purchase by a customer and incentive data between point-of-sale and one or more remote computers on a substantially real-time basis.
- b. Group VI invention lacks group II's feature of detecting at a computer a plurality of incentives to be communicated to a plurality of customers and compiling all incentives associated with respective customers into a single document.

Art Unit: 2164

- c. Group VI invention lacks Group III's feature of communicating a price variation for a product in response to determination that a desired product purchase criteria is achieved.
- d. Group VI invention lacks Group IV's feature of automatically communicating credit to the retail store for redemption of coupons presented by a customer.
- e. Group VI invention lacks Group V's feature of communicating the price of an item to be displayed to an electronic shelf tag from a computer connected to the Internet.

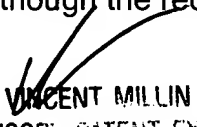
9. Because the inventions identified in groups I-VI above are distinct for the reasons given above and the search required for each group is distinct and specific to the distinct features outlined above a restriction for examination purposes as indicated is proper. Furthermore, it would be great burden upon the office to distinguish the patentable inventions among searching the prior art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 2100 is (703) 746-7239 or 7238. Draft or Informal faxes for this Art Unit can be submitted to (703) 746-7240. Draft faxes may also be submitted directly to the examiner at (703) 746-5563.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

JNP 12/04/01


VINCENT MILLIN
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 2100